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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/502,509

05/05/2005

Richard McCormick

2171105-000002

8115

49840

7590

09/12/2008

BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ  
SIX CONCOURSE PARKWAY  
SUITE 3100  
ATLANTA, GA 30328

EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/502,509	<b>Applicant(s)</b> MCCORMICK, RICHARD	
	<b>Examiner</b> C. SAYALA	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/2005</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4-15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence (Virginia Cooperative Extension, Animal and Poultry Sciences, Publication 406-473, 16 pages, 2000).

See pages 6 and 7 which list lysine, calcium, copper, zinc, magnesium and iodine for horses.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (US Patent 6338856).

All of the claimed elements are disclosed at col. 6, see col. 8, line 16+, which teach that this composition is for horses.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (US Patent 6451370).

See col. 2, line 63 to col. 3, line 3 which list all the elements intended for horses.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nutrient Requirements for Horses, (The National Academy of Sciences, 1989, pages 15-17, 23-24, 34, 43-48, 95).

Claim 1 is fully anticipated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Allen et al. (US Patent 6338856), Anderson (US Patent 6451370), Nutrient Requirements for Horses, (The National Academy of Sciences, 1989, pages 15-17, 23-24, 34, 43-48, 95), AU 753033, Betz (US Patent 4166867), SU 1391570 and Ott et al. (J. Anim. Sci., vol. 49, No. 3, pages 620-628, 1979) in view of Graham et al. (J. Anim. Sci., 1994, 72:380-386) and further in view of Lawrence (Virginia Cooperative Extension, Animal and Poultry Sciences, Publication 406-473, 10 pages, 2000) and "Horse Science" , downloaded from [http://4h.ifas.ufl.edu/curriculum/projects/animal\\_sci/horsepubs.htm](http://4h.ifas.ufl.edu/curriculum/projects/animal_sci/horsepubs.htm), 8 pages, 1989, published by National 4-H Council, MD 20815).

The primary references, some of them discussed above, disclose the ingredients of the composition of claim 1, such as copper, lysine, magnesium, calcium, zinc and iodine. The amounts taught are either not in the range claimed or disclosed in units that are different from those claimed. Note however, while the range of lysine claimed is 3-18 gms, the reference to Lawrence and "Nutrient Requirements" both disclose 19 gms., see Table 1 and page 43, respectively. With respect to claim 10, wheat and oats are shown by the AU patent at page 4. The patent is drawn to feed for horses. See also Betz at col. 2, lines 10-11. This patent is also drawn to feed for horses. Graham et al. teach the importance of threonine and lysine for horses.

With respect to claims 5-7, the additional elements are disclosed by Betz at col. 3, lines 35-40, the SU patent (abstract), Anderson at col. 2, line 61-col. 3, line 3, the AU patent at pages 7-9 and the claims and Allen et al. at col. 6.

With respect to claims 11-15, which recite the process limitation of feeding the composition to various horses at different ages, applicant is reminded that these are composition claims and applicants' claim is written in product-by-process format and as such, it is the novelty of the instantly claimed product that needs to be established and not that of the recited process steps. In re Brown, 173 USPQ 685 (CCPA 1972); In re Wertheim, 191 USPQ (CCPA 1976).

Furthermore, as to the amounts of various ingredients, it is not clear if the amounts shown by the numerous references overlap or are the same, since these amounts are in units that are different from those used in the claims. The number of references that have been used here show that the ingredients that are claimed in

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applicant's composition was well established at the time the invention was made, for feeding horses and their importance, each on its own merit, known in the art. When the claims are read in light of the specification, it is clear that applicant has optimized the ingredients added for balancing the rations in a horse feed with respect to oats.

Lawrence and "Horse Sense" show work sheets that one skilled in the art could use to balance the ration with respect to every ingredient including minerals, vitamins, cereal, etc. Therefore, even if the amounts of applicant's ingredients, which are the same as those shown by the applied references, it would have been obvious to one skilled in the art at the time the invention was made, to find such amounts based on each horse's needs by using such worksheets, for each ingredient of the feed composition.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/C. SAYALA/**

**Primary Examiner, Art Unit 1794**